

No. 14674.

IN THE

# United States Court of Appeals

FOR THE NINTH CIRCUIT

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HOMER E. GILLESPIE, CATHERINE L. GILLESPIE and  
GILLESPIE GAMES COMPANY, a Corporation,  
*Appellants,*

*vs.*

COMA F. NORRIS, Individually and Doing Business as  
C. F. NORRIS MANUFACTURING COMPANY,  
*Appellee.*

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## APPELLEE'S BRIEF.

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## TOPICAL INDEX

	PAGE
Jurisdictional statement .....	1
Statement of the case.....	2
Summary of argument.....	4
Argument A. The District Court was correct in granting defendant's motion for summary judgment when the basis therefor was determined solely on the disclosures found in the Dorsey and Andrew patents which were not considered or cited by the Patent Office during the prosecution of the Gillespie patent No. 2,595,669.....	5
Argument B. The Dorsey and Andrews patents are sufficient evidence of themselves to support the findings and conclusions of the District Court that the claims in suit define subject matter that is anticipated by disclosures made in these patents, and the Gillespie claims in suit are invalid for lack of novelty and invention .....	10

## TABLE OF AUTHORITIES CITED

CASES	PAGE
Danaher v. United States, 184 F. 2d 673.....	10
Hardt v. Kirkpatrick, 91 F. 2d 875.....	10
Jacuzzi Bros., Inc. v. Berkeley Pump Co., 91 U. S. P. Q. 27....	9, 11

STATUTES	
United States Code, Title 28, Sec. 1291.....	1
United States Code, Title 28, Sec. 1338(a).....	1

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### Jurisdictional Statement.

This appeal by plaintiffs is from a final judgment of the United States District Court for the Southern District of California, Central Division, dismissing on the merits plaintiffs-appellants' complaint for patent infringement. The District Court had jurisdiction of the action under 28 U. S. C. 1338(a) and the judgment being final, this Court has jurisdiction under 28 U. S. C. 1291.

### Statement of the Case.

Plaintiffs-appellants' suit is for alleged infringement of Claims 1-3, 11-14 of their patent No. 2,595,669 for a Disk Game Apparatus.

The claims in suit define a device in which disk-like playing pieces are manually propelled from an elevated launching platform onto a playing field that has targets thereon, which device also includes a rotary sweep by which the playing field may be periodically cleared of accumulated playing pieces.

In Claims 1-3 of the plaintiffs' patent the alleged invention is defined as a combination of elements comprising the entire game, while Claims 11-14 define the horizontal disk launching platform without the sweep means.

After issue was joined on pleadings in the District Court, the defendant made a motion for summary judgment urging that the Gillespie patent was not infringed inasmuch as the patent was invalid for the following reasons:

- (a) The subject matter defined by Claims 1-3 and 11-14 was not novel and not the result of invention, and
- (b) The subject matter defined by Claims 1-3 and 11-14 had been in public use for more than one year prior to the filing date of the application from which the Gillespie patent No. 2,595,669 matured.

The defendant based his contention that the subject matter of Claims 1-3 and 11-14 was neither novel nor

the result of invention on the disclosures made in United States Letters Patents No. 725,684 issued to Dorsey in 1903 and No. 2,160,349 issued to Andrews in 1939. The plaintiff has admitted that neither of these two prior art patents were considered by the United States Patent Office during the prosecution of the Gillespie application that resulted in said patent in suit.

Numerous affidavits and counter-affidavits were filed by defendant and plaintiffs relative to the question of prior public use of the Gillespie device.

The defendant's motion for summary judgment was argued and submitted for decision to the District Court which found that in view of the prior Dorsey and Andrews patents, the claims in suit of plaintiffs' patent were neither new nor the result of invention and therefor concluded that these claims were invalid. In view of the complete disclosures found in the Dorsey and Andrews patents of all potentially novel subject matter of the Gillespie device, the Court based its findings of fact and conclusions of law thereon, and made no findings of fact relative to the prior use of devices embodying the alleged novel subject matter shown and claimed in the Gillespie patent.

Although the trial court made no findings of fact on the issue of prior public use of devices embodying the alleged novel subject matter comprising the Gillespie device, plaintiffs saw fit in their statement of points on appeal to state that the Court was in error to grant



defendant's motion for summary judgment based upon affidavits. Plaintiffs further belabored this contention by designating many of these affidavits for printing in the record.

### **Summary of Argument.**

A. The District Court was correct in granting defendant's motion for summary judgment when the basis therefor was determined solely on the disclosures found in the Dorsey and Andrew patents which were not considered or cited by the Patent Office during the prosecution of the Gillespie patent No. 2,595,669.

B. The Dorsey and Andrews patents are sufficient evidence of themselves to support the findings and conclusions of the District Court that the claims in suit define subject matter that is anticipated by disclosures made in these patents, and that the Gillespie claims in suit are invalid for lack of novelty and invention.



### Argument A.

The District Court Was Correct in Granting Defendant's Motion for Summary Judgment When the Basis Therefor Was Determined Solely on the Disclosures Found in the Dorsey and Andrew Patents Which Were Not Considered or Cited by the Patent Office During the Prosecution of the Gillespie Patent No. 2,595,669.

Appellants open their brief on page 1 thereof with the misleading statement, to-wit: "After answer was filed, defendants made a motion for summary judgment, and said motion was submitted to the trial court on affidavit and counter-affidavits. The motion for summary judgment was granted, . . ."

The statement above quoted does not give this Court a true picture of what occurred in the trial court, as appellants have seen fit to withhold the fact that the motion for summary judgment was also supported by disclosures made in the W. E. Andrews patent No. 2,160,349 [Tr. Vol. II, pp. 82-84] and the L. J. Dorsey patent No. 725,684 [Tr. Vol II, pp. 86-88].

Appellants have also withheld from this Court the damaging fact that the District Court's findings of fact and conclusions of law [Tr. Vol. I, pp. 71-72] are based solely on the disclosures found in the Dorsey and Andrews patents, and not on affidavits or counter-affidavits.

The Andrews patent [Tr. Vol. II, pp. 82-84] describes and claims a game having a horizontal playing field on which targets are defined, and having side wall enclosures

extending upwardly from the edges of the field. The Andrews device also includes means for removing playing disks from the field, as well as a cover that has a number of spaced, vertically disposed slits formed therein through which a player can traject disks onto the playing field in an effort to secure a winning score.

The alleged invention broadly comprises a combination of the following elements:

1. A horizontal playing field having targets thereon,
2. An enclosure extending upwardly from the outer edge of said playing field and supporting a horizontal playing piece launching platform at an elevated position thereabove,
3. A transparent cover disposed above said enclosure that defines a slit-like aperture relative to said launching platform through which disks may be trajected through the air onto the playing field, and
4. Means to sweep or displace disks from the playing field.

The operation of the Andrews device and appellants' alleged invention are identical, for in both, the player attempts to traject disk-like playing pieces onto a playing field to secure a winning score, and both devices are provided with means to remove the playing pieces from the playing field.

Appellants' device performs exactly the same function as the Andrews' invention, and differs therefrom only in the fact that the Gillespie device has an elongate hori-

zontal slit through which the playing pieces can be trajected rather than a number of vertically disposed slits. In addition, the Gillespie device includes a horizontal platform on which the playing pieces rest prior to being trajected through his elongate slit.

Dorsey discloses a game that comprises a playing field on which targets are defined, enclosures extending upwardly from the edges of the playing field, and an elevated platform on which disk-like playing pieces are disposed prior to trajection thereof onto the playing surface. Like that of Andrews, the Dorsey invention performs exactly the same function as appellants' device.

Therefore, in view of the Andrews and Dorsey patent disclosures, the only question before the District Court was whether it amounted to invention for Gillespie to rotate the vertical coin-receiving slits of Andrews 90° in order to provide the elongate horizontally positioned slit through which disk-like playing pieces could be trajected, as well as to provide a platform on which the playing pieces could be rested before being so trajected.

The District Court found that in view of the Andrews and Dorsey patent disclosures, the Gillespie device as defined in Claims 1-3 and 11-14 thereof was not novel and did not amount to invention.

Appellants contend that it was error for the District Court to so find, and in support of this contention, point out on page 8 of their brief that the Andrews slits prevent aiming of the disk-like playing pieces. This con-

tention cannot be taken seriously, inasmuch as with the Andrews device, aiming of the playing piece is accomplished by choosing a particular one of the large number of slits available from which the playing piece may be discharged there through. In using appellants' device, the playing piece is simply moved longitudinally along an elongate slit until a desired location is found from which the playing piece is to be trajected.

Thus, whether a player uses either the Andrews invention or appellants' device, before trajecting the disk onto the playing surface he must make a choice. When using the Andrews invention the player selects a particular slit, and when using appellants' device, a particular location on an elongate slit must be selected. It will be apparent that in either case, aiming of the playing piece toward a particular location on the playing field is possible.

Appellants also contend that Gillespie's use of a platform amounts to invention, particularly in view of an alleged need for such a game incorporating same by the game industry. Here again, appellants' contention cannot be taken seriously, for when Gillespie decided to provide a game incorporating horizontal slits, it must have been obvious that a shelf or platform would be convenient for use therewith. This concept of using a platform from which playing pieces can be trajected is clearly shown in the Dorsey patent.

Appellants also contend that the District Court erred in taking the issues presented by the pleadings from a



jury. The recognized function of a jury is to find facts. The facts before the District Court that invalidated the claims in suit were the disclosures made in the Dorsey and Andrews patents, and there was no issue between the parties as to the contents of these patents. Therefore, there obviously was no error made in not having a jury decide the issue presented to the District Court.

Although when a United States patent is granted it is presumed to be valid, this presumption of validity may be overthrown by a single patent which was not considered by the Patent Office. In *Jacuzzi Bros., Inc. v. Berkeley Pump Co.*, 91 U. S. P. Q. 27 (C. C. A. 9, 1951), this court stated,

“But further, a great many of the patents, which were brought to light in this lawsuit and considered by the Trial Court, had not been previously considered by the Patent Office. Even one prior art reference, which has not been considered by the Patent Office, may overthrow the presumption of validity, and, when the most pertinent art has not been brought to the attention of the administrative body, the presumption is largely dissipated. Such is the case here.”

Such is also the case in the present instance by reason of the argument above given.

### Argument B.

The Dorsey and Andrews Patents Are Sufficient Evidence of Themselves to Support the Findings and Conclusions of the District Court That the Claims in Suit Define Subject Matter That Is Anticipated by Disclosures Made in These Patents, and the Gillespie Claims in Suit Are Invalid for Lack of Novelty and Invention.

In the first point of appellants' argument they have not challenged a single finding of fact, but instead have discussed at some length what constitutes invention, and have urged the merits of Gillespie's alleged invention in light thereof.

The mere fact that the losing party is unhappy with the judgment of the District Court (as is always the case) does not of itself require the Appellate Court to re-try the case. Appellants must show an appealable error. This appellants have failed to do.

"It is the appellant's duty to bring up a record that discloses error. Every intendment should be in favor of the lower court's judgment." (*Hardt v. Kirkpatrick*, 91 F. 2d 875, 878 (C. A. 9, 1937).)

"The burden of showing grounds on which a judgment should be reversed rests on the appellant, *Elias v. Clarke*, 2 Cir., 143 F. 2d 640, certiorari denied, 323 U. S. 778, 65 S. Ct. 191, 89 L. Ed. 622. . . ." (*Danaher v. United States*, 184 F. 2d 673, 675 (C. A. 8, 1950).)

The findings of the District Court in the present instance are based solely on the contents of the Andrews and Dorsey patents. Such findings were sufficient to

invalidate the claims in suit. Therefore, appellants' contention that they should have the right to introduce additional evidence as to the operation of Gillespie's alleged invention, the need in the game industry for such a device, the commercial success of the Gillespie device, and acts of the appellants is without merit, for this evidence would simply augment the Andrews and Dorsey patent disclosures, which disclosures alone invalidate the claims in suit.

Inasmuch as appellants have failed to challenge a single finding, the decision of the District Court should be affirmed.

In *Jacuzzi Bros., Inc. v. Berkeley Pump Co.*, 91 U. S. P. Q. 29 (C. C. A. 9, 1951), this court stated,

'If the findings were based wholly on written documents without expert interpretation, the Trial Judge must find the facts and it is not true that we are in as good a position to find the facts from the written documents as he was. Furthermore, the law does not commit the function to us, but solely the power to reverse if his findings be clearly erroneous. Rule 52, Federal Rules of Procedure.'

In view of the foregoing reasons, and based upon cited authorities, it is respectfully requested that the judgment be affirmed.

Respectfully submitted,

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